

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appln. Of: COLVIG
Serial No.: 10/674,298
Filed: September 29, 2003
For: APPARATUS AND METHOD TO PROVIDE ...
Group: 3651
Examiner: Prakasam, Ramya DOCKET: TUC920030087US1

Board of Patent Appeals and Interference
US Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPELLANTS' REPLY BRIEF

This Reply Brief is being filed in support of Appellants' Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences, and in response to the Examiner's Answering Brief mailed November 20, 2007. In the event there are any fee deficiencies or additional fees are payable, please charge them, or credit an overpayment, to our Deposit Account No. 502262.

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STATUS OF CLAIMS

Claims 1-36 are pending. Claims 1-36, stand rejected and are on appeal. The claims on appeal are set forth in **CLAIMS APPENDIX A** appended to Appellants' Opening Brief.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1, 13, and 25, are unpatentable under 35 U.S.C. § 103(a) over Plutt et al. (U.S. Pat. No. 6,591,164) in view of Dimitri et al. (U.S. Pub. No. 2002/0062167).
2. Whether claims 2, 14, and 26, are unpatentable under 35 U.S.C. § 103(a) over Plutt et al. in view of Dimitri et al. et al and Grobler (U.S. Pat. No. 6,799,084).
3. Whether claims 3, 4, 6, 8, 9, 11, 15, 16, 18, 20, 21, 23, 27, 28, 30, 32, 33, and 35, are unpatentable under 35 U.S.C. § 103(a) over Plutt et al. in view of Dimitri et al.
4. Whether claims 5, 7, 10, 12, 17, 19, 22, 24, 29, 31, 34, and 36, are unpatentable under 35 U.S.C. § 103(a) over Plutt et al. in view of Dimitri et al. et al and Grobler.

ARGUMENTS ON APPEAL

I. THE EXAMINER INCORRECTLY ASSERTS THAT PLUTT ET AL. TEACH USE OF AN ACCESSOR COMPRISING A LIFTING SERVO SECTION, WHEREIN THAT LIFTING SERVO SECTION COMPRISES A FIRST GRIPPER AND A SECOND GRIPPER

A. *In The Grounds Of Rejection Section, The Examiner Acknowledges That Plutt Et Al. Fails To Teach Use Of An Accessor Comprising A Lifting Servo Section, Wherein That Lifting Servo Section Comprises A First Gripper And A Second Gripper*

In the Answering Brief, the Examiner expressly admits that “Plutt, however, fails to explicitly disclose the use of an accessor with a lifting servo section, such that the first and second gripper are on the lifting servo section.” Answering Brief at Page 12, Lines 3-4. The Examiner looks to Dimitri et al. to cure the deficiencies of Plutt et al. “Dimitri discloses the use of an accessor with a lifting servo section . . .” Page 12 at Lines 4-5.

As set forth in greater detail in Appellants’ Opening Brief, the Examiner misplaces reliance on the teachings of Dimitri et al. Dimitri et al. nowhere teach use of an accessor comprising two grippers.

B. *In The Remarks Section The Examiner Asserts That Plutt Et Al. Does Teach Use Of An Accessor Comprising A Lifting Servo Section Comprising A First Gripper And A Second Gripper*

Curiously, the Answering Brief contradicts itself. As noted hereinabove, the Examiner expressly admits that Plutt et al. fails to teach use of an accessor comprising a lifting servo section, wherein that lifting servo section comprises a first gripper and a second gripper. In the Remarks Section of the Answering Brief, however, the Examiner interprets Plutt et al. differently, and incorrectly asserts that Plutt et al. DOES teach use of an accessor comprising a lifting servo section, wherein that lifting servo section comprises a first gripper and a second gripper. “An accessor is provided (121-126-See Figure below) wherein said accessor

comprises a first gripper (See Figure below) and a second gripper (See Figure below). Both grippers are disposed on the accessor (See Figure below), and are disposed on a lifting servo section (131-133). Therefore, these limitations are disclosed.” Answering Brief on Page 13 at Lines 5-9.

Plutt et al. expressly define elements 121-126 as a system of rails. “A system of rails 121-126 is used to guide robotic pods 102 through all of the locations in the array . . .” Col. 2 at Lines 31-33. Nevertheless, the Examiner, for the first time on appeal, equates the system of rails taught by Plutt et al. with a first accessor and a second accessor as recited in all of Appellants’ claims on appeal.

Using the Examiner’s newly-asserted theory that the rails of Plutt et al. comprise a plurality of accessors, an analysis of the elements of Appellants’ claims 3-12, 15-24, and 27-36, demonstrates the fallacy of the Examiner’s argument. Appellants’ claims 3-12, 15-24, and 27-36, recite a method, an article of manufacture which implements that method, and a computer program product which implements that method, wherein the method requests use of a second accessor, and determines if use of the second accessor is authorized, and operates the second accessor if use of that second accessor is authorized.

In the Answering Brief the Examiner renews the assertion that Plutt et al., Dimitri et al., and Grobler, in combination teach the elements of Appellants’ claims 3-12, 15-24, and 27. Under the Examiner’s thesis that the system of rails 121-126 taught by Plutt et al. comprises a plurality of accessors, then rail system 121 comprises a first accessor and rail system 122 comprises a second accessor.

Appellants trust the Board will appreciate that Plutt et al., in combination with Dimitri

et al and Grobler, nowhere teach or suggest a method that uses a first rail system, such as rail system 121, but does not use a second rail system, such as rail system 122, wherein that method requests use of the second rail system, determines if use of that second rail system is authorized, and operates that second rail system if use of that second rail system is authorized.

Plutt et al. recites no such teaching. This being the case, the Examiner's newly-made assertion that Plutt et al. teaches use of an accessor comprising a lifting servo section, wherein that lifting servo section comprises a first gripper and a second gripper, should be accorded no merit whatsoever.

Appellants respectfully submit that Plutt et al. in combination with Dimitri et al. and Grobler nowhere teach or suggest use of an accessor comprising a lifting servo section, wherein that lifting servo section comprises a first gripper and a second gripper, as recited by all of Appellants' claims on appeal.

II. THE EXAMINER'S "AUTHORIZED BY NECESSITY" ARGUMENT FAILS TO SUSTAIN THE REJECTIONS OF APPELLANTS' CLAIMS 1, 2, 13, 14, 25, AND 26

Appellants' claims 1, 2, 13, 14, 25, and 26, recite a method, an article of manufacture which implements that method, and a computer program product which implements that method, wherein that method, *inter alia*, operates a first gripper but not a second gripper wherein both grippers are disposed on a lifting servo section element of an accessor, requests use of the second gripper, determines if use of the second gripper is authorized, and operates the second gripper if use of that second gripper is authorized. The Examiner implicitly acknowledges that neither Plutt et al., nor Dimitri et al., singly or in combination, teach or suggest a method, or an article of manufacture which implements that method, or a computer

program product which implements that method, wherein that method requests use of a second gripper disposed on an accessor, determines if use of the second gripper is authorized, and operates the second gripper if use of that second gripper is authorized, as recited in Applicants' claims 1, 2, 13, 14, 25, and 26.

The Examiner attempts to justify the deficiencies of Plutt et al. and Dimitri by asserting that a request to use the second gripper, and an authorization to use that second gripper, are not required. Rather as the Examiner must acknowledge, Plutt et al. teach that "the use of the second gripper is **determined based on necessity**, therefore the use of the second gripper is authorized and the operations mode is changed based on this determination." Answering Brief on Page 13 at Lines 19-21 (emphasis added).

In essence, the Examiner asserts that Plutt et al. pre-authorize use of spare and/or redundant grippers. As the Examiner must acknowledge, when a spare or redundant gripper is needed, under Plutt et al. that resource is automatically provided. In marked contrast, Appellants' claims 1, 2, 13, 14, 25, and 26, require that a request for use of a second gripper be made, and a determination made whether use of that second gripper is authorized.

Under *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007) and *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966), an obviousness determination turns on the "scope and content of the prior art" and the "differences between the prior art and the claims." Regarding the "scope and content of the prior art," Plutt et al. in combination with Dimitri et al. teach that use of the second gripper is determined based on necessity. Regarding the "differences between the prior art and the claims," Appellants' claims 1, 2, 13, 14, 25, and 26, recite, *inter alia*, that use of the second

gripper is based upon a request therefore, and a determination that use of the second gripper is authorized. Thus under Appellants' claims, even if necessity were to dictate that use of the second gripper is required, that necessity would not be sufficient.

The failure of Plutt et al. to teach the requesting element and the determination element of Appellants' claims 1, 2, 13, 14, 25, and 26, strikes at the heart of the Examiner's obviousness rejections. Appellants respectfully submit that their claims 1, 2, 13, 14, 25, and 26, are patentable over the teachings of Plutt et al. and Dimitri.

III. THE EXAMINER'S "AUTHORIZED BY NECESSITY" ARGUMENT FAILS TO SUSTAIN THE REJECTIONS OF APPELLANTS' CLAIMS 3-12, 15-24, AND 27-36

Appellants' claims 3-12, 15-25, and 27-36, recite a method, an article of manufacture which implements that method, and a computer program product which implements that method, wherein that method, *inter alia*, operates a first accessor but not a second accessor, requests use of the second accessor, determines if use of the second accessor is authorized, and operates the second accessor if use of that second accessor is authorized. The Examiner implicitly acknowledges that neither Plutt et al., nor Dimitri et al., nor Grobler, singly or in combination, teach or suggest a method, or an article of manufacture which implements that method, or a computer program product which implements that method, wherein that method requests use of a second accessor, and determines if use of the second accessor is authorized, and operates the second accessor if use of that second accessor is authorized.

The Examiner attempts to justify the deficiencies of Plutt et al., Dimitri et al., and Grobler, by asserting that a request to use the second accessor, and an authorization to use that second accessor, are not required. Rather as the Examiner must acknowledge, Plutt et al. teach

that "the use of the second gripper is **determined based on necessity**, therefore the use of the second gripper is authorized and the operations mode is changed based on this determination."

Answering Brief on Page 14 at Lines 20-22 (emphasis added).

In essence, the Examiner asserts that Plutt et al. pre-authorize use of spare and/or redundant accessors. As the Examiner must acknowledge, when a spare or redundant accessor is needed, under Plutt et al. that resource is automatically provided. In marked contrast, Appellants' claims 3-12, 15-24, and 27-36, require that a request for use of a second accessor be made, and a determination made whether use of that second accessor is authorized.

Under *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007) and *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966), an obviousness determination turns on the "scope and content of the prior art" and the "differences between the prior art and the claims." Regarding the "scope and content of the prior art," Plutt et al. in combination with Dimitri et al. and Grobler teach that use of the second accessor is determined based on necessity. Regarding the "differences between the prior art and the claims," Appellants' claims 1, 2, 13, 14, 25, and 26, recite, *inter alia*, that use of the second accessor is based upon a request therefore, and a determination that use of the second accessor is authorized. Thus under Appellants' claims, even if necessity were to dictate that use of the second accessor is required, that necessity would not be sufficient.

The failure of Plutt et al. to teach the requesting element and the determination element of Appellants' claims 3-12, 15-24, and 27-36, strikes at the heart of the Examiner's obviousness rejections. Appellants respectfully submit that their claims 3-12, 15-24, and 27-36, are patentable over the teachings of Plutt et al, Dimitri et al., and Grobler.

CONCLUSION

In view of the foregoing, Appellants respectfully request that the Examiner's rejection of the subject application be reversed in all respects.

Respectfully submitted,

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is herewith being electronically transmitted via Electronic Filing System to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

/Kim Good/

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January 22, 2008

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